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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,359	07/01/2003	Denise R. Barbut	161,700-052	5397
34263	7590	12/23/2004	EXAMINER	
O'MELVENY & MEYERS			TANNER, HARRY B	
114 PACIFICA, SUITE 100				
IRVINE, CA 92618			ART UNIT	PAPER NUMBER
			3744	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/612,359	Applicant(s) BARBUT, DENISE R.	
	Examiner Harry B. Tanner	Art Unit 3744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-2, 4-5, 7, 10-11, 13-14, 16 and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Macoviak et al (6,139,517). Macoviak discloses an aortic shunt having first tubular member with expanding cylindrical balloon 244 engaging the lumen of the aorta and second tubular member 252 with a plurality of ports within the first tubular member and having an adjustable diameter in order to control the blood flow to the carotid arteries (see Figures 9a and 9b).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macoviak et al (6,139,517) as applied to claim 1 above and further in view of Don Michael. Don Michael teaches the use of a catheter that carries a body comparable to a stent in order to deliver chemical or biological material (see col. 2, lines 33-40). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have modified the system of Macoviak such that it included a stent in order to deliver chemical or biological material in view of the teachings of Don Michael.

Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macoviak et al (6,139,517) as applied to claim 1 above, and further in view of Aillon. Aillon teaches the use of a manometer in order to measure the pressure in the catheter (see col. 3, lines 34-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Macoviak such that it included the use of a manometer in order to measure the pressure in the catheter in view of the teachings of Aillon.

Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macoviak et al (6,139,517) as applied to claim 1 above, and further in view of Avellanet. Avellanet teaches the use of radiopaque markers in order to locate the position of the catheter (see col. 2, lines 49-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Macoviak such that it included the use of radiopaque markers in order to locate the position of the catheter in view of the teachings of Avellanet.

Applicant's arguments filed on 10/12/04 have been fully considered but they are not persuasive. Applicant contends that the since the claims recite that the second tubular member communicates with a port on the intermediate portion of the first tubular member that Macoviak (6,139,517) does not disclose every limitation of the claims because distal end of second tubular 252 does not communicate with a port mounted

on an intermediate portion of first tubular member 242. It is noted that applicant's "port" on the intermediate portion of the first tubular member 20 is formed by an opening in the expansion member 10 that is in communication with the plurality of ports 33 at the distal end of the second tubular member (see Figures 1A-2B and pages 9-10 of the specification). Macoviak forms a port mounted on an intermediate portion of first tubular member defined by the opening between the expansion members 244 and 258 and the central tubular wall 242 (see Figure 9b). This port communicates with the plurality of ports 256 of the second tubular member 252. The shape of the port of Macoviak is different from that of applicant (i.e. it encircles the first tubular member whereas applicant's port as shown in Figures 1A, 2A and 2B is only on one side of the first tubular member, but both ports are mounted the intermediate portion of the first tubular member and in communication with the plurality of ports on the distal end of the second tubular member.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry B. Tanner whose telephone number is (571) 272-4813. The examiner can normally be reached 8:30 am to 6:00 pm Monday, Wednesday, Thursday and Friday and 2:00 pm to 6:00 pm Tuesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise Esquivel, can be reached on (571) 272-4808. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Harry B. Tanner", is positioned above the printed name.

Harry B. Tanner
Primary Examiner
Art Unit 3744